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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/522,117 03/09/00 CALDWELL

W 627-311CT

020792 HM22/0220
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EXAMINER

BALASUBRAMANIAN, V

ART UNIT

PAPER NUMBER

1624

DATE MAILED:

02/20/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/522,117

Applicant(s)

Caldwell et al.

Examiner
Venkataraman Balasubramanian

Group Art Unit
1624



☐ Responsive to communication(s) filed on _____

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 21-27 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 21-27 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1624

DETAILED ACTION

Applicants' response, which included cancellation of claims 12-20 and addition of new claims 21-27, filed on 12/6/2000 is made of record.

Claims 21-27 are now pending.

In view applicants' response, particularly in limiting the new claims 21-27 to species N-methyl-5-(5-isopropoxy-3-pyridyl)-4-penten-2-amine, its R, S, and Cis and Trans forms, applicants have rendered all 112 rejections made previously on the genus claims 12-20 moot. In addition, applicants have rendered 102 rejections made in the previous office action as the prior art cited did not disclose the specific species presently embraced. Furthermore, all 103 rejection made in the previous office action have been obviated. However, the following apply.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caldwell et al. US 5,861,423.

Caldwell et al. teaches several pyridinyl substituted olefinic amines claimed herein for the treatment of central nervous disorders. See formula shown on col. 5 and note the definition of A, A', A'', X, X', E', E'', Z', Z'' groups and value of m, n, p shown on col. 5-6. Note with the above

Art Unit: 1624

definition of various groups, reference compounds include compound claimed herein. Note some species are shown as cis and trans forms (ie present as Z and E forms). See example 4 on col. 16 which shows N-methyl-4-3-(5-isopropoxy-pyridinyl)-3-buten-1 amine.

While said compound doesn't anticipate the scope of claims 21-27, they are very closely related, being homologs of compounds i.e. instant pentene vs butene of the reference. However, homologs and compounds that differ only by a CH₂ are not deemed patentably distinct absent evidence of superior or unexpected properties. *In re Wood* 199 USPQ 137; *In re Lohr* 137 USPQ 548. Thus it would have been obvious to one skilled in the art at the time of the invention was made to expect instant compounds to possess the utility taught by the applied art in view of the close structural similarity outlined above.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 21-27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 09/631,761.

Art Unit: 1624

Although the conflicting claims are not identical, they are not patentably distinct from each other because subject matter embraced herein is also embraced in the copending application 09/631,761.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 21-27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 09/631,761. Although the conflicting claims are not identical, they are not patentably distinct from each other because subject matter embraced herein is also embraced in the copending application 09/570,226

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicants should note that these two cases are not available to the examiner and the subject matter appear to overlap with the instant claims.

Again examiner wishes to thank the applicants for disclosing several copending applications. Although most of them appears to have non overlapping subject matter, some are not available to the examiner. Applicants should therefore identify those copending applications that may have overlapping subject matter to avoid obviousness-type double patenting.

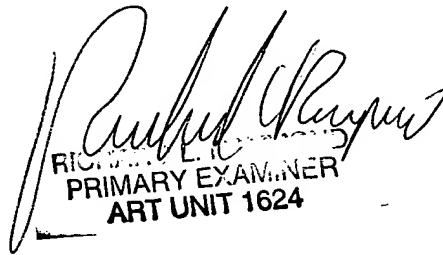
This action is not made Final.

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (703) 305-1674. The examiner can normally be reached on weekdays from 8.30 AM to 5.00 PM.

Art Unit: 1624

The fax phone number for the organization where this application or proceeding is assigned
(703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the receptionist whose telephone number is (703) 308-1235.


RICHARD L. K. [unclear]
PRIMARY EXAMINER
ART UNIT 1624

VB

V. Balasubramanian (Bala)

2/16/2001